



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/649,039	08/27/2003	James J. Kernz	16514	5136
43935 7590 03/15/2007 FRASER CLEMENS MARTIN & MILLER LLC 28366 KENSINGTON LANE PERRYSBURG, OH 43551			EXAMINER LEVINE, ADAM L	
			ART UNIT 3625	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/15/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/649,039

Applicant(s)

KERNZ, JAMES J.

Examiner

Adam Levine

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 59-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 59-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant filed amendments and remarks dated December 22, 2006, in reply to the office action mailed September 19, 2006. Claims 4,5,6,7,8,9,12, and 13 have been amended. Claims 10,11,67, and 68 were previously withdrawn in response to requirement for election/restriction. Originally filed claims 17-58 were previously cancelled in response to the same requirement. Claims 79 and 80 are newly filed. Replacement drawing sheets have been filed for figures 14-21. Claims 1-16, and 59-80 are currently pending. Claims 10,11,67, and 68 having been withdrawn, claims 1-9, 12-16, 59-66, and 69-80 are treated in this office action.

Response to Amendment

Pertaining to objections to the drawings in the prior office action

The drawings were objected to for the various reasons indicated in the "Notice of Draftsperson's Patent Drawing Review," PTO-948, accompanying the prior office action (Paper #20060904). Corrected replacement drawing sheets were filed. The objections are withdrawn.

Pertaining to rejections under 35 USC §112 in the prior office action

Claims 6 and 8 were rejected under section 112 in the prior office action because they were drafted with language that appeared internally contradictory, or at least inconsistent. In any case they were indefinite. Claims 6 and 8 have been adequately

amended. As noted by the applicant the rejections are now moot and they are therefore withdrawn.

Response to Arguments

Applicant's arguments filed December 22, 2006, have been fully considered but they are not persuasive.

Pertaining to rejections under 35 USC §103(a)

Applicant admits that "a taxonomy of products and services is defined and a companion data dictionary of predetermined characteristics is linked to electronic files including descriptive terms representing a plurality of products or services," but argues that the identity of the parties and the perspective of the parties intended to be served by the disclosure are distinguishing characteristics. The disclosures taken in their entirety may ultimately be distinguishable on these bases, but a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is also noted that claims 1,59,70, and 75, argued by the applicant, do not specify the parties involved, although for the reasons noted above merely identifying the parties would not be sufficiently distinguishable. Also, the "user" in the prior art could be understood as applying to either buyer or seller depending on the circumstances. Finally, the prior art discloses the seller citing data characterizing the product or service, including characteristics that are graded, such as

reliability. Any grading scale will be predetermined as grades assigned to various comparable objects would be meaningless without a predetermined scale.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the art of grading objects," and the significant and substantial detail regarding "commoditizing objects" that applicant argues would distinguish the claims, etc.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Commoditizing is disclosed in the prior art to the extent the concept is claimed.

Regarding the remarks that Paskowitz does not disclose encapsulating the object with the grade indicator in a tamper-evident holder, and that Mayer does not teach a trading method for storing relevant data in a database, the trading method for storing relevant data in a database is taught in Paskowitz and the encapsulation with the grade indicator taught in Mayer. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon

Art Unit: 3625

hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it has been held that a prior art reference must be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the prior art describes the particular problem thus:

"When valuable coins are sold or traded, it is often difficult for the purchaser to verify the authenticity and value of the coin being actually purchased. This is because it is easy for an unscrupulous seller to substitute a coin of lesser value for the original coin intended to be purchased.

The prior art has recognized this problem and provides for many different types of devices intended to prevent or provide evidence of unscrupulous practices in commercial coin transactions. These devices are generally in the form of a case formed from a pair of transparent plastic plates which sandwich the coin and its authentication certificate therebetween. The plates are then permanently secured together, such as by ultrasonically bonding interlocking edge portions of the plates. The bonded plates form a unitary assembly which is tamperproof and

Art Unit: 3625

allows the purchaser to view both sides of the coin and determine its authenticity at the time of its purchase.” (Mayer, US Pat. No. 5,042,650; cited in Paper #20060904).

It would have been obvious to one of ordinary skill in the art at the time of the invention to look to a reference reasonably pertinent to the particular problem with which the inventor was involved.

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-16 and 59-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paskowitz (Paper #20060904; US Patent No. 6,377,937) in view of Mayer (Paper #20060904; US Patent No. 5,042,650).

Paskowitz teaches a method and system for grading and commoditizing objects, making them trade ready. Paskowitz teaches grading an object based upon a predetermined grading scale and generating a grade indicator for the object (see at least abstract, figs.1-6, column 3 lines 20-30, column 6 lines 32-58). Paskowitz teaches commoditizing the object by generating relevant textual trade data for the object and storing the relevant textual trade data in a database in a form for use in generating a trade listing for the object (see at least abstract, figs.3,5; column 1 lines 16-34, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9). Paskowitz further teaches:

- performing these steps for a plurality of objects: providing access to the relevant textual trade data in the database to sellers to generate trade listings for the objects (see at least abstract, column 6 lines 32-58); providing access to the trade listings to the sellers and to buyers within an online peer-to-peer trading environment (see at least figs.1,6; column 1 lines 8-14, column 2 lines 50-64).
- assigning a unique identifying indicia to the object: connecting the database to a host computer, connecting a remote terminal to the host computer, sending the unique identifying indicia from the remote terminal to the host computer and retrieving from the database for viewing at the remote terminal the relevant textual or digitized image trade data for the object associated with the unique identifying indicia, providing relevant trade data to at least one online trade enabling facility (see at least fig.2, column 1 lines 8-14, column 3 lines 20-30, 50-59 (retrieving and displaying product information through the internet inherently involves a remote computer retrieving information from a database through a

host computer), column 9 lines 48-60. The image or text data is descriptive material and is not functionally involved in the recited steps of the method.

Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106). The provision of the data described can occur either in advance or contemporaneous with the trade listing); each of the unique identifying indicia is an assigned unique certificate number having a predetermined format (Please note: the format of the identifying indicia is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381 , 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).).

- the object is at least one of a coin, a stamp, a trading card, currency and a document: the stored relevant textual trade data is at least one of a plurality of item specific attributes including a certificate number, a year of mintage indicator, a Mint branch indicator, a denomination indicator, type designation, grade indicator, and grading firm identifier (Please note: in the context of this invention, the nature of the objects only affects the information presented within the descriptive material. It has no actual role in the method. The description of the object is therefore descriptive material and is not functionally involved in the

recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106).

- generating trade listings: from the stored relevant textual trade data in at least one trade enabling marketplace computer and providing access to the trade listings to the sellers and to buyers of the objects through computers connected to the marketplace computer (see at least abstract, figs. 1, 3, 5, 6; column 1 lines 8-34, column 2 lines 50-64, column 6 lines 32-58, column 8 lines 32-47, line 65 - column 9 line 9).

Paskowitz teaches all of the above as noted and teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of communicating data concerning the objects between buyers and sellers. Paskowitz however does not disclose encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder and associating the assigned unique identifying indicia with the object encapsulated in the tamper-evident holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder. Mayer teaches a) associating the grade indicator with the object, b) assigning a unique identifying indicia to each of the objects, and c) a method of communicating data concerning the objects between buyers and

sellers. Mayer also teaches encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to the object and associating the assigned unique identifying indicia with the object encapsulated in the tamper-evident holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, indicia being visibly conspicuous thereby indicating that the objects are trade ready (see at least abstract, figs.1-5). Mayer further teaches:

- providing a substantially planar upper enclosure element for receiving at least partially a coin retaining insert: (see at least abstract, figs.1-5).
- providing a substantially planar lower enclosure for receiving at least partially a coin retaining insert: (see at least abstract, figs.1-5).
- providing a coin retaining insert adapted for close fitting between the upper and the lower enclosure element: the coin retaining insert having an appropriately dimensioned aperture for confining the coin: (see at least abstract, figs.1-5).
- mounting the coin within the aperture of the coin retaining insert: (see at least abstract, figs.1-5).
- confining the insert including the coin between the upper and lower enclosure elements: (see at least abstract, figs.1-5).
- sealing the enclosure elements using sonic welding means: (see at least abstract, column 3 lines 51-68).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and system of Paskowitz to include encapsulating objects, associating the grade indicator with the object in a substantially permanent manner by encapsulating the object and a visual representation of the grade indicator in a tamper-evident holder, assigning a unique identifying indicia to each of the objects and associating the assigned unique identifying indicia with the corresponding one of the objects encapsulated in the holder in a substantially permanent manner, printing the assigned associated unique identifying indicia onto a label and securing the printed label within the tamper-evident holder, the indicia being visibly conspicuous, as taught by Mayer, in order to verify the authenticity and value of the object being sold or traded, increasing confidence in the objects traded through the method and system and correspondingly increasing the use of the method and system in commerce.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Woolston, US Patent No. 5,845,265 (Dec. 1, 1998): teaches method and apparatus for transacting in used and collectible goods through an electronic network of consignment stores. Teaches establishment of trusted computerized market, including inventory tracking, virtual presentment of goods, and providing for identification of authenticity, condition, and other special attributes of items.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine
Patent Examiner
March 9, 2007


MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600